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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. | |
|------------------------------|----------------|----------------------|-------------------------|-----------------------|--|
| 09/808,130 | 03/15/2001 | Hiroyuki Horiuchi | HIG05 002 | 4640 | |
| 7. | 590 03/23/2004 | | EXAMINER | | |
| Duane Morris LLP | | | HESS, BRUCE H | | |
| 1667 K Street I Suite 700 | NW | | ART UNIT | ART UNIT PAPER NUMBER | |
| Washington, DC 20006 | | | 1774 | | |
| | | | DATE MAIL ED: 02/22/200 | 4 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) | | | | |
|--|------------------------------------|---|--|--|--|--|
| | . 09/808,130 | HIROYUKI HIRIUCHI | | | | |
| Office Action Summary | Examiner | Art Unit | | | | |
| | Bruce H Hess | 1774 | | | | |
| The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply | | | | | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE | | | | | | |
| 1) Responsive to communication(s) filed on | 13.03 (Amendment | After Final) | | | | |
| | –· action is non-final. | | | | | |
| 3) Since this application is in condition for allowa | nce except for formal matters, pro | osecution as to the merits is | | | | |
| closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | | | | | |
| Disposition of Claims 4) Claim(s)is/are pending in the application. | | | | | | |
| 4) (Saim(s)is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. | | | | | | |
| , | | | | | | |
| 5) Claim(s) is/are allowed. 12 6) X Claim(s) is/are rejected. | | | | | | |
| 7) Claim(s) is/are objected to. | | | | | | |
| 8) Claim(s) are subject to restriction and/c | or election requirement. | | | | | |
| Application Papers | | | | | | |
| 9) The specification is objected to by the Examiner. | | | | | | |
| 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. | | | | | | |
| Applicant may not request that any objection to the | | | | | | |
| Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. | | | | | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | | | | | |
| 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). | | | | | | |
| a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). | | | | | | |
| * See the attached detailed Office action for a list of the certified copies not received. 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78. a) ☐ The translation of the foreign language provisional application has been received. | | | | | | |
| 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78. | | | | | | |
| Attachment(s) | | | | | | |
| Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO-1449) Paper No(s) | 5) Notice of Informal | y (PTO-413) Paper No(s) Patent Application (PTO-152) | | | | |

Application/Control Number: 09/808,130

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1. In view of new rejections, the final rejection is withdrawn.

2. All claims (i.e., 4, 5,7,8,11, and 12) are rejected under 35 USC 112 (first paragraph) as being based upon a non-enabling disclosure.

In particular, the claims recite a foreign test procedure (i.e. JIS P 8143).

Applicants can overcome this rejection by either 1) submitting a translation of the standard or b)actually incorporating the standard into the specification.

3. All claims are rejected under 35 USC 112 (second paragraph) as being indefinite in the recital of "a recording material back surface" (emphasis added; see line 6 of claims 4 and 11).

Does "a" refer to the claimed recording material or to a different recording material. If the claimed recording material is intended, recitation of "[a] the recording material back surface " is suggested.

4. The art rejection set fourth in the final rejection is no longer adhered to for the reasons set forth by applicants. In particular, the patent to Umise et al. is directed to a donor sheet, not a receiving sheet as presently claimed. The Umise et al. discussion of coefficients of friction is with respect to different layers on the back of a donor element, not with respect to the relationship between the front and back of a receiving element. It is further noted that when taken together, the claimed apparent density and dynamic friction coefficient constitute a result-effective parameter (see Tables 1 and 2 in applicants' specification).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is (571) 272-1525. The examiner can normally be reached on Monday to Friday 9 Am to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Brue Horse

B. Hess/af March 10, 2004

BRUCE H. HESS